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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,452	12/13/1999	TIMO TAPANI TOKKONEN	NC24603	1166

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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT PAPER NUMBER

2682

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

all

# Office Action Summary

Application No.

09/459,452

Applicant(s)

TOKKONEN

Examiner

ELISEO RAMOS-FELICIANO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 18, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Jun 18, 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Drawings*

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on June 18, 2002 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### *Specification & Claim Objections*

2. Applicant's amendment filed on June 18, 2002 overcomes previous objection to the specification and previous objection to *claim 12*.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-5, 8, 11-18, 21, and 24-26** are rejected under 35 U.S.C. 102(b) as being anticipated by Mizikovsky (U.S. Patent Number 5,559,860).

Regarding **claims 1-5, 8, 11-18, 21, and 24-26**, Mizikovsky discloses a mobile station 10 (communication device) and a method for generating a response (reminder) when an incoming call is received. One way the user generates the "reminder" is by entering into a keypad 42 a text reminder, such as identifying data representing particular calling parties, for example: telephone

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numbers (selected phone numbers). The text reminder is stored into a memory 46 and displayed on a video screen (display) by means of a CPU 40 (processor) command when the particular calling telephone number matches with memory (triggering event). As disclosed in the abstract, at column 5, line 66 to column 6, line 43, column 7, line 51 to column 8, line 65, column 9, lines 34-45, column 13, lines 1-24, and as exhibited in FIGURE 1.

Another way the user pre-programs (generates) the "reminder" is by selecting among different audible alerts (audio reminder) or by recording (voice input) a verbal report (audio reminder) or indication of the calling party, such as name, telephone number or the like. As disclosed in the abstract, at column 2, lines 32-37, column 3, lines 1-11, column 5, lines 3-25, column 6, lines 11-33, column 8, lines 13-19 & 50-65, and FIGURE 5.

In summary (from above citations), Mizikovsky teaches that upon receipt of an incoming call the mobile station 10 (communication device) plays or displays to the user, for example, an audible alert, a recording, a verbal report, or an indication of the calling party, such as name, telephone number or the like. Each one of these features (audible alert, recording, verbal report, indication of the calling party, name, telephone number, etc.) reads as "a reminder". The "action" taken in response to a triggering event is to play or display such "reminder", and the "event" that triggers such "action" is the receipt of an incoming call. The action is in fact associated with the reminder, for example: the audible alert, recording, and verbal report are played; the calling party name, telephone number or the like are displayed.

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Mizikovsky teaches that it is the self user who pre-programs (generates) the "reminder". Such programming is resident in a memory of the mobile station 10 (communication device). All and each one of the reminder, the triggering event indication, as well as the action associated with the reminder must inherently reside together in memory, that is, "indexed together" as claimed.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 6-7 and 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizikovsky (U.S. Patent Number 5,559,860) in view of Johnson et al. (U.S. Patent Number 5,664,063).

Regarding **claims 6-7 and 19-20**, Mizikovsky discloses everything claimed as applied above (see *claim 1*). However, Mizikovsky fails to specify that the "reminder" could be a video reminder as defined by applicant.

Johnson et al. discloses a method for automatically reminding a remote communication device user of certain events. The user generates the "reminder" by specifying an audio segment or a video message reminder, as disclosed at column 4, lines 42-53, column 5, lines 15-31, and in the abstract. The advantage of a video reminder is that it provides enhanced and more

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comprehensive information for the user of the communication device, which is more attractive for certain consumers.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a video reminder or a video reminding function as taught by Johnson et al. in Mizikovsky's mobile station 10 (communication device) because this would provide enhanced and more comprehensive information to the user; therefore better marketing possibilities for the manufacturer.

7. **Claims 9 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizikovsky (U.S. Patent Number 5,559,860) in view of Villa-Real (U.S. Patent Number 4,481,382).

Regarding **claims 9 and 22**, Mizikovsky discloses everything claimed as applied above (see *claim 1*). However, Mizikovsky fails to specify that the triggering event could be an outgoing phone call as defined by applicant.

Villa-Real discloses a cordless telephone 1 (communication device) with an audio-visual reminder system for outgoing future phone calls. The user may program the telephone's memory for pre-arranging and scheduling a multitude of outgoing phone calls. An audio-visual reminder will help to avoid forgetting those important calls, as disclosed at column 1, lines 10-39 & 50-63, column 5, lines 25-37, column 8, lines 23-68, *inter alia*.

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use Mizikovsky's reminder method/apparatus in connection with outgoing calls because it will help the user to avoid forgetting those important calls.

8. **Claims 10 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizikovsky (U.S. Patent Number 5,559,860) in view of Tognazzini (U.S. Patent Number 5,790,974).

Regarding **claims 10 and 23**, Mizikovsky discloses everything claimed as applied above (see *claim 1*). However, Mizikovsky fails to specify that the triggering event could be an external event determinable by a sensor as defined by applicant.

Tognazzini discloses a portable calendaring apparatus 12, e.g. a two-way wireless pager (communication device), with a reminder alarm. The reminder alarm advises the user if there is a change in traffic or the location (external event) of the calendaring apparatus 12 (communication device). The apparatus 12 includes a GPS receiver 42 (sensor) and a traffic receiver 44 (sensor) for determining the changes, as disclosed in the abstract, at column 1, lines 10-21, and exhibited in FIGURE 1.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use Mizikovsky's reminder method/apparatus in connection with an external event, such as a change in traffic or the location of the communication device, because in that way the user may be advised if there is a conflict in his schedule due to unforeseen circumstances.

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***Response to Arguments***

9. Applicant's arguments filed on June 18, 2002 have been fully considered but they are not persuasive.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the indication of the triggering event and the reminder are indexed together) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). These features/limitations are new to the claims and have now been treated to the merits as explained above.

11. Concerning the terms "reminder", "event" and "action", as explained above Mizikovsky teaches that upon receipt of an incoming call the mobile station 10 (communication device) plays or displays to the user, for example, an audible alert, a recording, a verbal report, or an indication of the calling party, such as name, telephone number or the like. All of these (audible alert, recording, verbal report, indication of the calling party, name, telephone number, etc.) read as "a reminder" as claimed. The "action" taken is to play or display such "reminder", and the "event" that triggers such action is the receipt of an incoming call. The language of the claims do not distinguish the claimed method/apparatus from the prior art. The rejection is proper.



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*Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any response to this Office action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314

for formal communications intended for entry, informal communications or draft communications; in the case of informal or draft communications, please label "PROPOSED" or "DRAFT".

Hand-delivered responses should be brought to

Crystal Park II  
2121 Crystal Drive  
Arlington, VA  
Sixth Floor (Receptionist).

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is (703) 305-0078. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin, can be reached on (703) 308-6739. The fax phone number for this Group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700, or call Group customer service at (703) 306-0377.

**ELISEO RAMOS-FELICIANO**  
**PATENT EXAMINER**

ERF/erf  
September 7, 2002.

  
9/7/02

**NGUYENT.VO**  
**PRIMARY EXAMINER**